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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/302,154	04/29/1999	EDWIN PETER DAWSON PEDNAULT	Y0999-214	6531

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EXAMINER

KAPADIA, MILAN S

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 11/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/302,154

Applicant(s)

PEDNAULT, EDWIN PETER  
DAWSON

Examiner

Milan S Kapadia

Art Unit

2143

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.


NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, <sup>request for reconsideration</sup> the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONEClaim(s) objected to: NONEClaim(s) rejected: 1-20.Claim(s) withdrawn from consideration: NONE

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

Continuation of 5. does NOT place the application in condition for allowance because Applicant's After Final Amendment has been considered but fails to overcome the cited references and the finality of the previous Office Action is maintained. In response to Applicant's first argument on pages 4 and 5, the Examiner maintains that the prior art teaches the claimed limitations. In particular the Examiner maintains, in contrast to the Applicant, that Apte's "actual pure premium" is different than "actual predicted value of the pure premium." Apte at col. 4, lines 28-33, clearly indicates that the "actual pure premium" has a value of "\$350." This value of "\$350" is not predicted but entered by the user as the desired quarterly pure premium, col. 4, lines 9-16. In response, to Applicant's argument on page 5, the Examiner respectfully notes that Apte's system is processed by software, col. 3, lines 20-32. Furthermore, it is respectfully noted that there is no requirement in the claim language that the steps of "generating on the basis..." and "selecting a final plurality..." be only done by the software process. As such, the Examiner maintains that Apte does teach the claimed features. In response to Applicant's second and third arguments on pages 5 and 6, the Examiner notes that Apte clearly teaches that the system is operated by software, col. 3, lines 20-32. The Examiner notes that Simoudis was brought in just to show that after a software system is established by the prior art (Apte), the use of a computer-readable medium is within the knowledge of a skilled artisan and would have been an obvious modification of the teachings of Apte. In response to Applicant's third through fifth arguments on pages 6 and 7 of Applicant's response, the Examiner has considered the Applicant's submitted affidavit, but finds the affidavit non-persuasive. Specifically, the Applicant has failed to point to any relevant portions of the originally-filed specification that provide Applicant's argued definition of "actual pure premium" and "estimated pure premiums." As MPEP § 2106 states: "Office personnel should determine if the original disclosure provides a definition consistent with any assertions made by applicant." See, e.g., *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). Section 2106 further notes that if the applicant asserts that a term has a meaning that conflicts with the term's art-accepted meaning, Office personnel should encourage the applicant to amend the claim to better reflect what applicant intends to claim as the invention. Therefore, the Examiner has given claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Moreover, if a patent teaches or suggests the claimed invention, an affidavit or declaration by patentee that he or she did not intend the disclosed invention to be used as claimed by applicant is immaterial. *In re Pio*, 217 F.2d 956, 104 USPQ 177 (CCPA 1954). In addition MPEP § 716.01(c) states in assessing the probative value of an expert opinion, the examiner must consider the nature of the matter sought to be established, the strength of any opposing evidence, the interest of the expert in the outcome of the case, and the presence or absence of factual support for the expert's opinion. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986). In particular See *Ex parte Gray*, 10 USPQ2d 1922 (Bd. Pat. App. & Inter. 1989) (statement in publication dismissing the "preliminary identification of a humanb-NGF-like molecule" in the prior art, even if considered to be an expert opinion, was inadequate to overcome the rejection based on that prior art because there was no factual evidence supporting the statement); *In re Beattie*, 974 F.2d 1309, 24 USPQ2d 1040 (Fed. Cir. 1992) (declarations of seven persons skilled in the art offering opinion evidence praising the merits of the claimed invention were found to have little value because of a lack of factual support); *Ex parte George*, 21 USPQ2d 1058 (Bd. Pat.App. & Inter. 1991) (conclusory statements that results were "unexpected," unsupported by objective factual evidence, were considered but were not found to be of substantial evidentiary value). In response to Applicant's sixth, seventh, and eighth arguments on page 7, the Examiner respectfully notes that the combination is supported by a motivation and the modification of a software system to use well-known computer readable mediums does not change the principle operation of the software system. In fact, as shown on pages 9 and 10 of Applicant's response, a "computer-implemented method" inherently possesses "means of storage and retrieval of program data and instructions to be used at a later time." As such, the Applicant even admits that the use of a computer-readable medium in a software operated system, such as Apte, is well within the reach of a skilled artisan. In response to Applicant's ninth argument on page 8, the Examiner reiterates, Somoudis was brought in just to teach the use of a computer readable medium in a system running on software is obvious to one with ordinary skill in the art. In addition, the Examiner respectfully notes that "data mining" is not recited in the claims and the Applicant has not pointed to any specific distinctions between the claim language and the applied prior art. In response to Applicant's tenth argument on pages 9 and 10, the Examiner notes there is no requirement for the motivation to come directly from the applied prior art, MPEP § 2143.01. As per Applicant's eleventh argument, the Examiner maintains the applied prior art teaches all the recited limitations as shown in the prior Office Action and incorporated herein. The Examiner also respectfully notes that the feature of "automatically optimizes model segments" is not recited in the claims.